REMARKS

Claims 16-35 are now pending in the application.

Applicants respectfully traverse the ground of rejection under 35 USC § 103 to claims 16-35.

The rejection (claims 16-17, 19-21, 24-35) under 35 USC § 103 as allegedly being unpatentable over US patent 6,453,414 to Ryu in view of US patent 5,717,886 to Miyauchi and US patent 5,822,184 to Rabinovitz.

This ground of rejection is respectfully traversed.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. In re Oetiker, 977 F.2d 1443 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all claim limitations must be suggested or taught by the prior art. In re Royka, 490 F. 2d 981 (CCPA 1970). All words in a claim must be considered in judging the patentability of the claims against the prior art. In re Wilson, 424 f.2d 1382 (CCPA 1970). It is well settled that a rejection based on 35 USC § 103 must rest on a factual basis, which the PTO has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, (Fed. Cir. 1995). The Examiner did not fulfill her duty to establish the factual basis of the rejection.

Regarding the primary reference Ryu, Here, Ryu merely mentions "PCMCIA" interface but amended claims require USB or IEEE 1394. Applicant notes that at the time Ryu patent filed, there was no USB or IEEE 1394 standard published and thus the Examiner can not combine Ryu with other references to render the instant invention. In addition, none of the references cited shows claimed language "informing the host the status of said storage device is the large capacity storage disk or the simulated floppy drive and the floppy diskette".

Furthermore, the Examiner also cites Rabinovitz to combine with Ryu to render the inventive claimed features "control module and determining a device

class protocol of a storage disk by a microprocessor and control module". Here, Rabinovitz shows "data storage devices such as hard disk or CD-ROM drives are disposed vertically in a stacked formation within the housing" (Rabinovitz, abstract). There is no teaching utilizing a control module and a microprocessor in a removable device that can be plugged into a host computer in which a disk controller resided within to determine a device protocol instead Rabinoviz teaches using host computer to determine the device protocol. This is **teach away from the claimed invention** that a control module and a microprocessor in the removable device to determine the device protocol. Thus, Rabinovitz does not teach claimed features and the combination of Ryu, Miyauchi, and Rabinaovitz does not render the claimed invention.

Therefore, the Examiner fail to provide a factual basis for all words in the independent claim and dependent claims to make a prima facie case of obviousness in judging the patentability of the claims against the prior arts.

Finally, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggest the desirability of the modification. In re Frich, 972 F.2d 1260 (Fed. Cir. 1992). The motivations provided by the Examiner is "would have allowed for much greater memory capacity" or "would have prevented having to design and build a special disk controlled with out this function". As mentioned above, Rabinaovitz does not mention utilizing a control module and a microprocessor within the removable device to determine the device protocol. Ryu uses PCMCIA card that does not use separate control module to increase storage capacity. The motivations are not and could not be suggested or taught by the respective prior arts. Thus, these motivations are just **hindsight** by the Examiner, which is prohibited by the statue and numerous case laws.

With above analysis, Applicant respectfully contends that the Examiner does not make a *Prima Facie* case based on the combination of Ryu, Miyauchi, and Rabinaovitz as **required** in 35 USC § 103. none of cited references teaches, nor combination of them teaches all limitations of claims 16-17, 19-21, 24-35.

The rejection (claim 18) under 35 USC § 103 as allegedly being unpatentable over US patent 6,453,414 to Ryu in view of US patent 5,717,886 to Miyauchi and US patent 5,822,184 to Rabinovitz, and further in view of US 5, 319, 751 to Garney.

All of the arguments presented above with regard to the rejection claim 16 are incorporated herein because the subject matters of claim 16 are recited in claim 18. Accordingly, the subject matter of claim 18 is patentable over the cited references.

The rejection (claims 22 and 23) under 35 USC § 103 as allegedly being unpatentable over US patent 6,453,414 to Ryu in view of US patent 5,717,886 to Miyauchi and US patent 5,822,184 to Rabinovitz, and further in view of US 4,541,019 to Precourt.

All of the arguments presented above with regard to the rejection claims 22 and 23 are incorporated herein because the subject matters of claim 16 are recited in claim 22 and 23. Accordingly, the subject matter of claims 42 and 50 is patentable over the cited references. In addition, nowhere Precourt teaches that "a LED indicator comprising one or a plurality of indicator devices which can show the working status of the semiconductor storage device, said LED power indicator (5) is electrically connected to said microprocessor and control module". The Examiner does not indicate which portion Precourt teaches the limitation in his Office Action.

The Applicant respectfully requested the Examiner to present with specificity for rebuttals/rejections to above remarks/claims and to point out specific citations that where Precourt teaches the features of the claimed language.

If the Examiner has any further question or would like to discuss this application in more detail, she/he is invited to call the applicant's agent at the telephone number given bellow.

Claims 16-35, which precisely define the invention, are in immediate condition for allowance. Accordingly, the applicant earnestly solicits favorable action.

Respectfully submitted,

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